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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/225,080 01/04/99 AU-YOUNG

J PF-0066-2-DI

EXAMINER

HM12/0731

LUCY J BILLINGS
INCYTE PHARMACEUTICALS INC
3174 PORTER DRIVE
PALO ALTO CA 94304

CANELLA, K

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

07/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/225,080

Applicant

Au-Young

Examiner
Karen Canella

Art Unit
1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 months MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 17, and 19-42 is/are pending in the application.
- 4a) Of the above, claim(s) 13, 17, and 19-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Response to Arguments

1. Claims 13, 17 and 19-42 are pending. Claims 13, 17 and 19-38, drawn to non-elected inventions, remain withdrawn from consideration. Claims 39-42 are under consideration.

Claim Rejections Withdrawn

2. The rejection of claims 39-42 under 35 U.S.C. 101, because the claimed invention is not supported by a specific, substantial, asserted utility, is withdrawn in light of the exhibits provided by the applicant.

Claim Rejections Maintained

3. The rejection of claims 39-42 under 35 U.S.C. 112, first paragraph, is maintained for reasons of record. Applicant has provided exhibit A to demonstrate that SEQ ID NO:2 is identical to Prostate Stem Cell Antigen. Applicant has also provided the reference by Reiter et al, "Prostate stem cell antigen: A cell surface marker overexpressed in prostate cancer" in an attempt to obviate the rejection under 35 U.S.C. 112. However, this has no bearing on the instant application which did not disclose the polypeptide of SEQ ID NO:2, the polynucleotides encoding said polypeptide obtained from a bladder tumor library, as a prostate stem cell antigen. The reference by Reiter et al represents information that was not available at the time of the instant invention, as the specification does not discuss SEQ ID NO:2 as a prostate stem cell antigen or the use of SEQ ID NO:2 in a diagnostic or therapeutic method. Furthermore, developments occurring after the filing date, i.e. identification of SEQ ID NO:2 as a prostate specific antigen, are of no consequence regarding what one of skill in the art believed as of the filing date the rejections stand. See *In re Wright*, 27USPQ 1510, 1514 (Fed. Cir. 1993)

4. The rejection of claims 39 under 35 U.S.C. 102(b) as being anticipated by any of Wilkie et al (Genomics, 1993) or Wray et al (Gene 1993) or Burton (Nature, 1993) or Gama et al (Mol. Microbiol., 1992) or Birkeland (Can J. Microbiol., 1994) or Arendt et al (Appl. Environ. Microbiol., 1994) is maintained for reasons of record. Applicant argues that a search of the databases does not unearth these sequences. Further, applicant has amended the claim 39 to recite "an immunogenic fragment comprising at least 5 contiguous amino acids of SEQ ID NO:2"

in order to obviate this rejection. This has been considered but not found persuasive as all the cited references provide polypeptides comprising at least 5 contiguous amino acids of SEQ ID NO:2.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Canella, Ph.D.
Patent Examiner, Group 1642
July 30, 2001


ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600